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In re Application of	:	DECISION ON
ALLEGRETTI et al.	:	
Application No.: 09/830,449	:	PETITION UNDER
PCT No.: PCT/EP99/07887	:	
Int. Filing Date: 18 October 1999	:	37 CFR 1.47(a)
Priority Date: 30 October 1998	:	
Attorney Docket No.: 0471-0260P	:	
For: PROCESS FOR THE PREPARATION OF	:	
ALPHA ARYLALKANOIC ACIDS	:	

This is a decision on applicants' "PETITION UNDER 37 C.F.R. § 1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 15 October 2001.

#### BACKGROUND

On 18 October 1999, applicants filed international application PCT/EP99/07887, which claimed a priority date of 30 October 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 11 May 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 03 May 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 30 April 2001.

On 27 April 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee and the surcharge under 37 CFR 1.492(e).

On 29 May 2001, a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 USC 371" (Form PCT/DO/EO/905) was mailed to applicants requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b). A two month extendable period for reply was set therein.

On 15 October 2001, applicants submitted the instant "PETITION UNDER 37 C.F.R. § 1.47(a)". The submission was accompanied by: a declaration of inventors; a petition under 37 CFR 1.47(a) including a declaration of facts by Marcello Allegretti, Maria Candida Cesta, and Marco Mantovanini; and a petition/fee for a three month extension of time.

## **DISCUSSION**

### **37 CFR 1.497(a)-(b)**

It is noted that the declaration of inventors accompanying the petition under 37 CFR 1.47(a) filed 15 October 2001 does not comply with 37 CFR 1.497(a)-(b). The declaration is defective because it is not clear what application is being executed. The declaration appears to attempt to execute two different applications: United States Application Number 09/830,449 as amended on 27 April 2001 and PCT international application PCT/EP99/7887. These applications are not identical; amendments made on 27 April 2001 are not part of the international application. A declaration of inventors submitted in an application filed under 35 U.S.C. 371 should not incorporate amendments which were not made during the international phase since such amendments are not part of the international application. Also, each executed declaration must identify each inventor and the citizenship of each inventor. The declaration accompanying the petition under 37 CFR 1.47(a) filed 15 October 2001 fails to identify the citizenship of Luca Nicolini. Consequently, a new oath(s) or declaration(s) in compliance with 37 CFR 1.497(a)-(b) is required.

### **Petition Under 37 CFR 1.47(a)**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to (1), the fee of \$130.00 has been paid.

As to (3), a statement of the last known address of Luca Nicolini has been provided.

As to (2), it is noted that applicants fail to show or provide proof that a copy of the application papers (specification, including claims, drawings, and oath or declaration) were presented to the non-signing inventor. The copies of the letters mailed to the non-signing joint inventor requesting his signature suggest that only an assignment document and power of attorney were sent.

Moreover, it is not clear whether it is being alleged that the nonsigning inventor refuses to execute the application or that he cannot be reached after diligent effort. Note that it is not clear that any of the mailings were received by the inventor. A copy of "the registered mail receipts" are provided but it is not clear what these receipts are intended to show. It is not clear if they are intended to show that the letters were received by the inventor, were returned as undeliverable, or the letters were simple deposited with the postal service. Also, it is noted that no dates appear on

these receipts. Finally, it is noted that a translation of the receipts has not been provided. Accordingly, it is not clear if the mailings were undelivered or lost, if the inventor is no longer at this address and his whereabouts are unknown, or if he simply received the mailings and did not respond. If the mailings were received and the inventor did not respond, then a refusal to execute the application would likely need to be established. See MPEP § 409.03(d). If it is being alleged that the inventor cannot be reached or found, copies of documentary evidence such as certified mail return receipt that support a finding that the nonsigning inventors could not be found or reached should be made part of the affidavit or declaration. Also, if it is being alleged that the nonsigning inventor cannot be found or reached, efforts made to locate him, such as finding a forwarding address or telephone number, should be discussed in the next petition.

Additionally, regarding the declaration of facts of Marcello Allegretti, Maria Candida Cesta, and Marco Mantovanini, it is noted that the “statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted.” MPEP § 409.03(d). Marcello Allegretti, Maria Candida Cesta, and Marco Mantovanini do not appear to have firsthand knowledge of the facts recited in the declaration.

As to (4), the declaration of inventors is not sufficient for the reasons set forth above.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(a) at this time.

### CONCLUSION

For the above reasons, applicants’ petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

Applicants are hereby afforded TWO (2) MONTHS from the mail date of this decision to file either 1) an oath or declaration in compliance with 37 CFR 1.497(a)-(b) signed by all inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a). Any reconsideration request should include a cover letter entitled “Renewed Petition Under 37 CFR 1.47(a).” No additional petition fee is required.

Failure to timely file the proper response will result in **ABANDONMENT** of this application.

Any further correspondence with respect to this matter should be addressed to the

Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



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